



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 9

**MICHAEL J. MALLIE
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
SEVENTH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES CA 90025-1026**

COPY MAILED

AUG 01 2003

OFFICE OF PETITIONS

In re Application of
Edward L. Schwartz, et al
Application No. 09/784,928
Filed: February 15, 2001
Attorney Docket No. 074451.P127

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.137(b)
:
:

This is a decision on the petition, filed May 20, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on December 11, 2001. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

Petitioner contends that "the USPTO has misinterpreted the requirements of 35 U.S.C. § 122, causing the needless filing of the subject Petition, and respectfully requests a refund under 37 CFR § 1.26 for the fees under 37 CFR § 1.17(m) mistakenly required to be paid." The petition fails to state with any specificity as to how the USPTO misinterpreted the rules.

However, petitioner's attention is directed to 35 U.S.C. 122(b)(2)(B) which states, in pertinent part:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will

not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) **An applicant may rescind a request made under clause (i) at any time.**

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. **A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned**, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

A review of the file record discloses that this application was filed with a proper nonpublication request. As noted above, on December 11, 2001, applicant filed a counterpart international application relating to the subject matter of the above-identified application. Thereafter, on February 13, 2002, applicant filed a Notice of Rescission of Nonpublication Request, but did not notify the

USPTO that this application was being filed as a counterpart international application. Notification of the filing of the counterpart international application as required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was provided at the time of filing of the instant petition.

The American Inventors Protection Act of 1999 required publication of certain patent applications filed on or after November 29, 2000, and allowed applicants to request nonpublication if the invention disclosed in the application had not been and would not be the subject of an application filed in another country, or pursuant to an international agreement that required publication of patent applications eighteen months after filing. The Act permitted applicants to rescind the nonpublication request at any time, but also required applicants to notify the USPTO if they had made a nonpublication request (with the certification that the invention disclosed in the application had not been and would not be "foreign filed," and then did foreign file). If an applicant requested nonpublication, and then did not provide notice of foreign filing no later than 45 days of the foreign filing, the statute provides that the application would be regarded as abandoned. An applicant who rescinded a nonpublication request after filing the U.S. application but before foreign filing the application is not understood to be required to also file a notice of foreign filing, since the rescinding of the nonpublication request prior to foreign filing would nullify the nonpublication request (if received in the USPTO prior to the date of foreign filing).

In view of the above and as the notification to the USPTO of the foreign filing on December 11, 2001 of the counterpart international application did not occur within 45 days of such filing, this application is regarded as abandoned as of midnight on January 25, 2002 pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Therefore, the appropriate relief from the abandoned status of this application is the filing of a petition under 37 CFR 1.137(b).

A petition to revive an application abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

- (1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. 35 U.S.C. § 41(c)(7). Therefore, the \$1,300 petition fee submitted is not refundable.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 2621 for examination in due course.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy